

### **REMARKS**

Claims 1-2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52 are pending. No new matter has been added.

Applicant responds to each of the Action's rejections in the order in which they are presented in the Action.

#### **I. Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52 Patentable over Katz**

In the July 01, 2010 Office Action, claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52 were rejected under 35 U.S.C. §102(b) as anticipated by Katz. Applicant respectfully traverses these rejections, as detailed below.

##### **A. German Patent No. DE 100 17 438 (Katz) does not anticipate Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52.**

The Office asserts that claim 1 is anticipated by Katz. On page 2 of the Office Action, in the discussion of the anticipation of claim 1, the Office states that "In regard to the functional language regarding three positions and two volumetric states, Katz has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of Katz is used in this fashion depends on a future act of use and not on any claimed structural difference." (see page 2 of the Office Action, lines 17-21).

Applicant asserts that the Office's reasoning is incorrect. The Office considers that when the plunger **3** in Katz is moved forwardly towards the outlet valve **13**, the content of the pumping chamber **7** is initially pushed (bled) into the container **2** through the channel **22** connecting therewith until the plunger **3** has moved sufficiently forwardly to cover the channel **22**, and thereafter continued forward movement of the plunger **3** pumps the remaining content of the pumping chamber **7** through the outlet valve **13**. This

finding is based on certain assumptions (*ex-hypothesi*) which are not clearly and unambiguously derived from the disclosure in Katz, but appear to be motivated by knowledge of the claimed invention (*ex post facto*).

A first assumption the Office makes is that the follow-on piston **23** is free to move in either direction, toward or away from the channel **22** connecting the container **2** and the pumping chamber **7**. The significance of this assumption is that it is needed by the Office to support the proposition for bleeding of content in the pumping chamber **7** back into the container **2** when the plunger **3** moves forwardly until it covers the channel **22**. This is because movement of the follow-on piston **23** away from the channel **22** would be needed to accommodate content bled back into the container **2**.

To this end, the Office indicates this assumption is supported by Figure 5. However, Figure 5 does not show the follow-on piston **23**. Moreover, even if this was intended to be a reference to Figure 1, there is nothing in Figure 1 (e.g. movement arrows) to support a finding that the follow-on piston **23** is free to move in either direction. Nowhere in Katz is there a clear and unmistakeable disclosure of this attribute which the Office assumes to exist.

Further, even if it can be established that the follow-on piston **23** is free to move in either direction, this does not inevitably mean that bleeding will occur. Being “**free** to move in either direction” (emphasis added) does not mean that movement away from the channel (rearwardly) actually takes place. This would still depend on what is the opening pressure threshold of the outlet valve **13** relative to the force need to move the follow-on piston **23** rearwardly and Katz provides absolutely no information on this.

The Office further suggests that there is no force biasing the follow-on piston **23** in any manner (see page 2-3 of the Office Action, lines 21-3). This assumption is also made to support the contention that the follow-on piston **23** is free to move rearwardly. Yet again, however, it does not address the point raised in the previous paragraph about conclusive evidence that the follow-on piston **23** does actually move rearwardly in use.

As importantly, though, this assumption ignores the disclosure in Katz that the follow-on piston 23 is frictionally engaged to the container inner wall (translation, page 3, first full paragraph, end of the penultimate sentence). So, there is a friction force which needs to be overcome to permit movement of the follow-on piston **23**. The fact that this force is overcome in the rearward return stroke of the plunger **3** does not inevitably mean that it would also be overcome in the forward stroke of the plunger **3**. Moreover, it is clearly possible that the frictional engagement is such that only one-way (forward) movement of the follow-on piston **23** occurs. The fact that this possibility does exist is another reason why the Office's assumption is flawed and must not be used to the Applicant's disadvantage.

The above assumption also seems to be based on the naming by Katz of element **23** as a "follow-on piston". In other words, the term itself supports the proposition for two-way movement of the element **23**. This also cannot be accepted. In fact, the purposive prefix "follow-on" is more indicative of one-way movement, of which the only clear disclosure in Katz is the forward movement towards the channel **22** in the filling phase of the device operation.

A further assumption made by the Office is that only when the plunger **3** is past the channel **22** is the pressure in the pumping chamber **7** sufficient to open the outlet valve **13**. So, on this basis, bleeding beforehand must take place. In this regard, the Office says support for this proposition is found in the Katz translation at page 3, first full paragraph. There is no information in this passage, or for that matter elsewhere in Katz, of the opening pressure threshold for the outlet valve **13**. So, absent such information, and contrary to the Office's standpoint, it is possible that the outlet valve **13** will open as soon as the plunger **3** is moved forwardly whereby no bleeding will take place. The only reference in the relied on passage in Katz to pressure in the context of the outlet valve **13** is in the last sentence which actually relates to the return stroke of the plunger **3** and the outlet valve **13** helping provide the negative pressure in the pumping chamber **7** for refilling thereof.

In conclusion, the features of claim 1 define properties for structural elements which are not clearly and unambiguously disclosed in Katz, and therefore Katz does not anticipate claim 1 nor the other claims which are directly or indirectly dependent thereon. The Office is not entitled to rely on *ex-hypothesi* findings which do not **clearly and unambiguously** derive from the disclosure in Katz or which are reliant on an *ex post facto* reading of Katz.

**II. Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52 Patentable over Katz in view of either Clay or Alfonso.**

In the July 01, 2010 Office Action, claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52 were rejected under 35 U.S.C. §103(a) as obvious by Katz in view of Clay. Applicant respectfully traverses these rejections, as detailed below.

**A. German Patent No. DE 100 17 438 (Katz) in view of Clay (6,413,499) does not render obvious Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52.**

Clay fails to disclose the elements of claim 1 that were lacking in Katz, as discussed in the section above. Thus, the asserted combination of Katz with Clay would not yield the subject matter of Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52. As such, the claims are not obvious. Withdrawal of the rejection is requested.

**B. German Patent No. DE 100 17 438 (Katz) in view of Alfonso (6,017,963) does not render obvious Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52.**

Alfonso fails to disclose the elements of claim 1 that were lacking in Katz, as discussed in the section above. Thus, the asserted combination of Katz and Alfonso would not yield the subject matter of Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52. As such, the claims are not obvious. Withdrawal of the rejection is requested.

In light of the above, Applicant respectfully asserts that Katz does not either anticipate or render obvious the subject matter of Claims 1, 2, 5, 7-8, 10-16, 18-29, 32-34, 36, 45-47 and 52 when read alone or in view of Clay or Alfonso. Applicant respectfully requests withdrawal of each of the rejections made.

### **III. Conclusion**

All claim rejections being addressed in full, Applicant respectfully requests the withdrawal of the outstanding objections and rejections and the issuance of a Notice of Allowance. Should the Examiner have any questions regarding the foregoing, Applicant respectfully requests that the Examiner contact the undersigned, who can be reached at (919) 483-9995.

Respectfully submitted,

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